

REMARKS

Upon entry of these amendments, claims 1-4, 8-9, 11-13, and 15 will be pending. Claims 8, 11, and 12 are currently amended. Claims 5-7, 10, and 14 are canceled. Claims 1-4 have been allowed by the Examiner. Claim 15 is new. Support for claim 15 is found in the original specification, including page 28. No new matter has been introduced through these amendments.

Allowable Subject Matter

Applicant appreciates the Examiner's allowance of claims 1-4.

Objection to Claim 11

Applicant appreciates the Examiner's acknowledgment that claim 11 would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims. Accordingly, claim 11 has been rewritten in independent form. Applicant respectfully submits that the objection is now overcome and should be withdrawn.

Rejections Based on Anticipation

Claims 8-10 and 12-14 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Cragg (U.S. Patent No. 6,558,390). Applicant respectfully traverses this rejection for the reasons stated below.

Object 96 in Cragg is not a marking pin.

The Examiner identifies object 96 in Cragg as a "marking pin." Applicant respectfully disagrees. Object 96 in Cragg is instead an "anterior tract sheath" (see, e.g., Cragg, column 23, line 16). As described by Cragg, the anterior tract sheath is a hollow cylindrical object through which various instruments may be passed (see, e.g., figure 14). The function of the anterior tract sheath in Cragg is fundamentally different from that of the marking pin in Applicant's invention. In Cragg, the anterior tract sheath functions as an instrument *through which various other instruments are*

passed and through which various procedures are performed. For example, Cragg describes passing various instruments through the lumen of the anterior tract sheath in order to perform a discectomy (see figures 14 and 21; column 23, lines 14-16; column 28, lines 35-41), vertebroplasty through direct injection of a bone growth material (see figures 25 and 26; column 31, lines 36-7), and balloon-assisted vertebroplasty (see figures 27-31; column 32, lines 25-6). Clearly, the anterior tract sheath in Cragg is not the marking pin in Applicant's invention.

A guidewire is not a marking pin.

Cragg does not disclose a marking pin, only a prior-art guidewire (see, e.g., column 18, lines 7-13). As Applicant has previously discussed (see pp. 7-8 and 26 of Applicant's original specification), guidewires are very different from the marking pin of Applicant's invention. Guidewires have proven difficult to use. Because a guidewire is a relatively long and thin wire, the structural integrity of the guidewire often fails during attempts to drive one end of the wire into the pedicle bone. Furthermore, because a guidewire bends and crimps during insertion, it does not provide a smooth and secure anchor for guiding subsequent tooling and pedicle screws to the entry point on the pedicle. In addition, current percutaneous guidewire systems are used in conjunction with C-arm fluoroscopy (or other radiographic device) without direct visualization with the use of an endoscope or microscope. Thus, current guidewire systems pose a potential risk of misplacement or pedicle breakage. Finally, because one end of the guidewire remains protruding out of the head of the pedicle screw and the patient's back, guidewires hinder the freedom of motion of the surgeon in performing the various subsequent procedures involved in spinal fixation surgery. Clearly, the guidewire found in Cragg and other prior art is not the marking pin in Applicant's invention.

Cragg does not disclose removing a guidewire prior to insertion of a securing member.

Solely for the purpose of expediting the prosecution of this application, Applicant has amended claim 8 to require "removing said marking pin prior to insertion of said securing member into said vertebral bone at said entry point." Similarly, Applicant has amended claim 12 to require a

“means for removing said marking pin prior to insertion of said securing member into said vertebral bone at said entry point.” These limitations were originally found in claims 10 and 14, respectively (both claims now canceled). It is important to note that removing a guidewire *prior* to inserting a securing member would negate the purpose of a guidewire. A guidewire is used by fitting another instrument or object *over the wire* and manually or mechanically advancing the object or instrument along the wire to the entry point. An example of this is found in Cragg, where an “over-the-wire bore enlarging tool having a flexible body capable of tracking the curved guidewire is *fitted over the proximal end of the guidewire* and manually or mechanically rotated and advanced along it” (see column 18, lines 9-13) (emphasis added). Removing a guidewire *prior* to inserting a securing member would render the method described by Cragg impossible. Clearly, the additional limitations incorporated into claims 8 and 12 further distinguish the marking pin of Applicant’s invention from prior art guidewires.

For the reasons stated above, Applicant respectfully submits that the Examiner’s rejections based on anticipation under 35 U.S.C. § 102(e) are now overcome and should be withdrawn.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no.559552000200. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: June 13, 2006

Respectfully submitted,

By 
Richard C. Kim
Registration No.: 40,046
MORRISON & FOERSTER LLP
12531 High Bluff Drive
Suite 100
San Diego, California 92130-2040
(858) 720-5142